

## **REMARKS**

By the present Preliminary Amendment, Applicants have amended Claims 5-11 and have cancelled Claims 1 and 54-76 from this application and have added Claims 77-101 to this application. Accordingly, Claims 2-53 and 77-101 are active in this application.

Applicants present the Preliminary Amendment in conjunction with a Suggestion For Interference Pursuant to 37 CFR § 41.202(a). The information required by 37 CFR § 41.202(a) is set forth under headings which correspond to the subsection of § 41.202 to facilitate consideration by the Examiner.

### **(1) Identification of Patent**

Applicants suggest an interference between this application and U.S. Patent No. 6,822,105 (“the ’105 Patent”), issued on November 23, 2004. In addition, Applicants suggest an interference between this application and U.S. Patent Application Serial No. 10/953,327 (“the ’327 Patent Application”), filed on September 29, 2004. The ’327 Application is a continuation of the application which matured into the ’105 Patent.

### **(2) Identification of Claims and Counts**

(i.) Applicants believe that the following claims of the ’105 Patent interfere with the subject matter set forth in Applicant’s application: Claims 1, 6, 7, 9, 10, 11, 12, 16, 17 and 18. Applicants believe that the following pending claims of the ’327 Application interfere with the subject matter set forth in Applicant’s application, as pending on September 29, 2004: Claims 1-5 and 7.

(ii.) The following counts are proposed:

#### **Proposed Count 1:**

A method of making fatty acid methyl esters from an oil source, such as a free

fatty acid feedstock, comprising:

- (A.) converting the free fatty acid in the oil source to mono-, di- and tri-glycerides by adding glycerin to the oil source;
- (B.) transesterifying the glycerides into fatty acid methyl esters by the addition of an alcohol to the mono-, di- and tri-glycerides; and
- (C.) recovering the fatty acid methyl esters.

Proposed Count 2

A method of making fatty acid methyl esters from an oil source, such as a free fatty acid feedstock, comprising:

- (A.) converting the free fatty acid in the oil source to mono-, di- and tri-glycerides by adding glycerin to the oil source;
- (B.) converting the glycerides into fatty acid methyl esters by reacting the glycerides with an alcohol; and
- (C.) recovering the fatty acid methyl esters.

(iii.) Correspondence of the Claims to the Proposed Counts.

Claim 1 of the '105 Patent corresponds to the proposed counts, as exemplified by

Proposed Count 2 set forth below:

Proposed Count 2	Claim 1 of the '105 Patent (showing statement from claim)
A method of making fatty acid methyl esters from an oil source, such as a free fatty acid feedstock, comprising:	"A method of making an alkylester comprising the following steps:  providing an oil source the oil source including free fatty acids";
(A.) converting the free fatty acid in the oil source to mono-, di- and tri-glycerides by adding glycerin to the oil source;	"contacting the glycerol source and oil source . . . for effective conversion of the free fatty acids . . . into a mixture of mono-, di-, and triglycerides";
(B.) converting the glycerides into fatty	"reacting the mixture of glycerides with the

acid methyl esters by reacting the glycerides with an alcohol; and	methanol for an effective conversion of glycerides into fatty acid alkyl esters;
(C.) recovering the fatty acid methyl esters.	“recovering the fatty acid alkyl esters.”

Claim 1 of the '327 Application principally differs from Claim 1 of the '105 Patent by specifying esterification with an alcohol, versus methanol.

### (3) Claim Chart

Below is a claim chart comparing the claim of each party:

Proposed Count 2	Claim 1 of '105 Patent	Claim 77 of Applicants
“A method of making fatty acid methyl esters from an oil source, such as a free fatty acid feedstock, comprising:	<b>A method of making an alkylester comprising the following steps:</b>  <b>providing an oil source, the oil source including free fatty acids and/or glycerides;</b>	“A process of making fatty acid methyl esters from a free fatty acid feedstock, comprising:
(A.) converting the free fatty acid in the oil source to mono-, di- and tri-glycerides by adding glycerin to the oil source;	providing a glycerol source of at least 0.3 equivalent; <b>contacting the glycerol source and oil source</b> for a sufficient time <b>for effective conversion of the free fatty acids and glycerides into a mixture of mono-, di-, and triglycerides</b>	(A.) converting the free fatty acid in the feedstock to mono-, di- and tri-glycerides by adding a glycerin product to the feedstock;
(B.) converting the glycerides into fatty acid methyl esters by reacting the glycerides with an alcohol; and	providing methanol in an excess between about 1.0 equivalents to about 3 equivalents; <b>reacting the mixture of glycerides with the methanol for an effective conversion of glycerides into fatty acid alkyl esters;</b>	(B.) transesterifying the glycerides into fatty acid methyl esters by the addition of an alcohol to the mono-, di- and tri-glycerides; and
(C.) recovering the fatty acid methyl esters.”	<b>recovering the fatty acid alkyl esters.</b>	(C.) recovering the fatty acid methyl esters.”

As set forth in the Table above, the claims of Applicants and the '105 Patent interfere and the '327 Application because the subject matter of Claim 1 of the '105 Patent and Claim 1 of the '327 Application would, if considered to be prior art to Applicants' claims, anticipate or render obvious the claimed subject matter of Applicants. The portion of Claim 1 of the '105 Patent which is not boldfaced above, merely represents the ratios one would anticipate based on the claimed reactants. Such limitations are further expressed in the specification of Applicants and are limitations which are unnecessary when viewed in light of the prior art.

To the extent any differences can be noted between Claim 1 of the '105 Patent and Claim 1 of the '327 Application and Applicants' Claim 77, such differences do not distinguish the claims.

(4) **Reasons Why Applicant Will Prevail on Priority.**

The application of Applicants was filed on January 26, 2004 and claims priority to U.S. provisional application serial no. 10/766,740, filed on January 27, 2003. The '105 Patent matured from an application that was filed on August 12, 2003. Applicants are unaware of any earlier date which can be relied upon by the patentees of the '105 Patent.

(5) **Claim Chart Establishing Written Description**

Support in the specification of U.S. Patent Application Serial No. 10/766,740 for the proposed Counts is set forth below wherein it is illustrated that Claim 1 of the '105 Patent and Claim 1 of the '327 Application corresponds to Proposed Counts 1 and 2

Claim 77 (Proposed Count 1)	Exemplary Passages From U.S. Patent Application Serial No. 10/766,740.
A method of making fatty acid methyl esters from an oil source, such as a free fatty acid feedstock, comprising:	P. 11; ll. 10-11 and 18-19.

(A.) converting the free fatty acid in the oil source to mono-, di- and tri-glycerides by adding glycerin to the oil source;	P. 43, ll. 11-13.
(B.) transesterifying the glycerides into fatty acid methyl esters by the addition of an alcohol to the mono-, di- and tri-glycerides; and	P. 44, ll. 13-16; p. 12, ll. 19-26.
(C.) recovering the fatty acid methyl esters.	P. 15; ll. 16-18.

Proposed Count 2	Exemplary Passages From U.S. Patent Application Serial No. 10/766,740.
A method of making fatty acid methyl esters from an oil source, such as a free fatty acid feedstock, comprising:	P. 11; ll. 10-11 and 18-19.
(A.) converting the free fatty acid in the oil source to mono-, di- and tri-glycerides by adding glycerin to the oil source;	P. 43, ll. 11-13.
(B.) converting the glycerides into fatty acid methyl esters by reacting the glycerides with an alcohol; and	P. 44, ll. 13-16; p. 12, ll. 19-26.
(C.) recovering the fatty acid methyl esters.	P. 15; ll. 16-18.

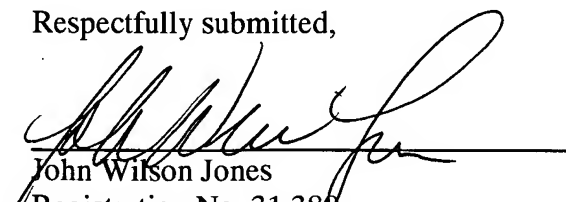
(5) Constructive Reduction to Practice Chart

Applicants desire to be accorded the benefit for the constructive reduction to practice in the following interfering subject matter as set forth in the Table below and suggest that the claims of the '105 Patent interfere with the patentable invention of Applicants as set forth below:

Interfering Subject Matter	Exemplary Passages From U.S. Patent Application Serial No. 10/766,740.
The production of fatty acid methyl esters (biodiesel) by	P. 11; ll. 10-11 and 18-19.
(i.) the converting free fatty acid in an oil source to mono-, di- and	P. 43, ll. 11-13; p. 20, ll.

tri-glycerides by adding glycerin to the oil source which includes free fatty acids and glycerides	6-10.
the glycerol being present being in excess of at least 30 percent	P. 51; ll. 20-21
the glycerol being purified glycerol	P. 43, ll. 19-21
the glycerol being recovered from transesterification of vegetable oil	P. 46, l. 3 through p. 47, l. 16 -
the glycerol and oil source being contacted between from 180° and 245° C	P. 14, ll. 16-18
the glycerol source and oil source being carried out to a residual value of below 5 percent	P. 25, ll. 20-22
the glycerol source and oil source being contacted at a reduced pressure ranging from 760 mmHg to 1 mmHg	P. 24, ll. 12-14
(ii.) converting the glycerides into fatty acid methyl esters by reacting the glycerides with an alcohol, such as methanol; and	P. 12, ll. 19-26; p. 44, ll. 13-16.
the alcohol being present in an amount between about 1.0 to about 300 percent	P. 53, ll. 9-10
(iii.) recovering the fatty acid methyl esters	P. 15; ll. 16-18.
the method being a continuous process	P. 14, l. 5 through p. 16, l. 19.

Respectfully submitted,

  
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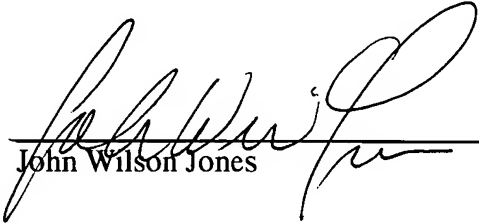
Dated: November 18, 2005

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November 18, 2005

  
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